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EXAMINER	
DUONG, OANH L	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. Rejection of claim 61 under 35 U.S.C 101 is withdrawn.

2. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chislenko et al. ("Chislenko"), US 6,041,311, in view of Chang, Us 2002/0168938 A1.

Regarding claim 61, Chislenko teaches a method comprising:

comparing, by a processing device, each of a plurality of user profiles with a target user profile of a first user associated with a media player device *(i.e., "comparing that user's profile with the profile of every other user of the system", col. 5 lines 51-55*);

selecting, by a processing device, a matching user profile from the plurality of user profiles (read as finding at least one other person with similar tastes) (i.e., *"similarity factors are used to select a plurality of users that have a high degree of correlation to a user", col. 8 lines 1-2*);

selecting a playlist (i.e., "The neighboring users are selected based on the similarity factors (step 106). The neighboring users are weighted, and recommendations for items are arrived", col. 11 lines 9-34); and

delivering a playlist to the media player device (i.e., to recommend/deliver (music) items/playlist to a user, col. 19 lines 41-42).

Chislenko does not explicitly teach a playlist of a matching user associated with the matching user profile.

Chang teaches system and method wherein coordinated and synchronized music playback among peer listeners is achieved. Chang teaches communicate a playlist of a matching user associated with the matching user profile (i.e., "*the local apparatus sends its own profile, which can be a list of song, to the remote party", page 2 paragraphs [0021] and [0024*]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement Chislenko's playlist as a playlist of a matching user associated with the matching user profile as taught by Chang. One would be motivated to do so to synchronize song playback between two or more users who wish to share mutual music listening (Chang, page 1 paragraph [0007]).

Response to Arguments

3. Applicant's arguments filed 10/19/2009 have been fully considered but they are not persuasive.

In the remarks, applicant's argued that

(A) Applicant respectfully submits that the finality of the Office Action is inappropriate in view of new rejection of claim 61 under 35 U.S.C. 101.

As to point (A), Examiner asserts that the finality of the Office Action is appropriate since Amendment filed on May 4, 2009 involved replacing feature "effecting selection" with "selecting" and feature "effecting delivery" with "delivery." Since it is not known that what effects the selection and delivery, it is not clear that the step of effecting selection and step of effecting delivery involve in any transformation to

different state or thing and/or being tied with an apparatus. By replacing feature "effecting selection" with "selecting" and feature "effecting delivery" with "delivery," it is clearly seen that steps of selecting and delivering as amended do not involve in any transformation or being tied with an apparatus. Therefore, the finality of the Office Action is appropriate in view of rejection of claim 61 under 35 U.S.C. 101.

In addition, the finality of the Office Action is appropriate and sustained since the rejection of claim 61 under 35 U.S.C. 101 has been withdrawn.

(B) Chislenko fails to teach or suggest selecting a matching user (Applicant's remark, page 9 line15).

As to point (B), it is noted that the features upon which applicant relies (i.e., "selecting a matching user") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(C) Chislenko likewise fails to teach or suggest selecting a playlist of a matching user, and delivering the playlist to the media player device (Applicant's remarks, page 9 lines 15-17).

As to point (C), Chislenko teaches selecting a playlist (i.e., selecting the number of items/playlist that are highly rated by the user's neighbors, col. 10 lines 3-6), and delivery the playlist to the media player device (i.e., "to recommend items to a user, col.

10 lines 7-21 and col. 19 lines 41-42). Chang teaches a playlist of matching user (i.e., if it is a good match, the local apparatus send it own profile/playlist to the remote party, page 2 paragraphs [0021] and [0024). Therefore, the combination of teachings of Chislenko and Chang does teach selecting a playlist of matching user and delivery the playlist to the media player device.

(D) "The Patent Office concedes that Chislenko fails to disclose selecting a playlist of a matching user associated with a matching user profile" (Applicant's Remarks, page 9 lines 18-20).

As to point (D), examiner respectfully submits that The Patent Office does not concede that Chislenko fails to disclose selecting a playlist of a matching user associated with a matching user profile." The Office Action indicated that Chislenko teach selecting a playlist. However, Chislenko does not teach a playlist is playlist of a matching user associated with the matching user profile, and Chang teaches a playlist of a matching user associated with the matching user profile.

(E) Change does not compare each of a plurality of user profiles with a target user profile (Applicant's remarks, page 9 lines 26-27).

As to point (E), Examiner respectfully submits that Chislenko teaches compare each of a plurality of user profiles with a target user profile *(i.e., "comparing that user's profile with the profile of every other user of the system", col. 5 lines 51-55*). It is noted that one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(F) Chang teaches away from selecting and delivering playlist to the media device associated with the target user (Applicant's remarks, page 10 lines 4-6).

As to point (F), Chang does not teach away from selecting and delivery playlist to the media device associated with the target user because Chang's disclosure does not criticize, discredit, or otherwise discourage the solution claimed.

Examiner respectfully submits that the feature "selecting and delivering playlist to the media device associated with the target user" is disclosed by Chislenko. It is noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(G) Applicant submits that one would not be motivated to combine the teachings of Chang with Chislenko.

As to point (G), In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.1992). In this case, Chislenko teaches a system comprises a plurality of user profiles and one profile may be created for each user (col. 3 lines 15-16). Change teaches if there is a good match between a local profile and a profile of a remote party, the *local apparatus sends its own profile, which can be a list of song, to a remote party (page 2 paragraphs [0021] and [0024*]). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teachings of Chislenko to send a local apparatus's own profile/playlist into Chislenko's system as taught by Change. One would be motivated to do so to allow song playback to be synchronized between two or more users who wish to share mutual music listening (Chang, page 1 paragraph [0007]).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to OANH DUONG whose telephone number is (571)272-3983. The examiner can normally be reached on Monday- Friday, 9:30PM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Oanh Duong/
Primary Examiner, Art Unit 2455